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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/504,605	02/15/2000	David Michael Geshwind	BW.FB	8116

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David M Geshwind
111 Fourth Avenue
New York, NY 10003

EXAMINER

KOSTAK, VICTOR R

ART UNIT	PAPER NUMBER
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2614

DATE MAILED: 07/06/2004

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

09/504,605

Applicant(s)

GESHWIND, DAVID MICHAEL

Examiner

Victor R. Kostak

Art Unit

2614

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --
Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☐ Responsive to communication(s) filed on ____.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-28 and 30-36 is/are pending in the application.
- 4a) Of the above claim(s) ____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) ____ is/are allowed.
- 6) ☒ Claim(s) 1-28 and 30-36 is/are rejected.
- 7) ☐ Claim(s) ____ is/are objected to.
- 8) ☐ Claim(s) ____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 15 February 2000 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
 - ☐ Certified copies of the priority documents have been received in Application No. ____.
 - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- ☒ Notice of References Cited (PTO-892)
- ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- ☐ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date ____.
- ☐ Interview Summary (PTO-413)
Paper No(s)/Mail Date. ____.
- ☐ Notice of Informal Patent Application (PTO-152)
- ☐ Other: ____.

Art Unit: 2614

1. Claim 6 is objected to because of the following informalities: in the first line of the claim, the term "information" should probably be inserted after "other". Appropriate correction is required.

Because there is no claim 29, claims 30-36 are also objected to as not being in compliance with rule 126.

2. The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

Claims 7-12 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

These claims all require that the first and second segments (introduced in base claim 1) are one and the same. This implies no separate entities. However, there must be a significant enough distinction between them in order for the supplemental information to be encoded with the first segment and subsequently utilized with – and not before the presentation of - the second segment.

Applicant may have intended to describe the segments as containing identical content or being duplicates but separated temporally, which would imply actual separate data segments.

3. The nonstatutory double patenting rejection is based on a judicially created doctrine grounded in public policy (a policy reflected in the statute) so as to prevent the unjustified or improper timewise extension of the "right to exclude" granted by a patent and to prevent possible harassment by multiple assignees. See *In re Goodman*, 11 F.3d 1046, 29 USPQ2d 2010 (Fed. Cir. 1993); *In re Longi*, 759 F.2d 887, 225 USPQ 645 (Fed. Cir. 1985); *In re Van Ornum*, 686

Art Unit: 2614

F.2d 937, 214 USPQ 761 (CCPA 1982); *In re Vogel*, 422 F.2d 438, 164 USPQ 619 (CCPA 1970); and, *In re Thorington*, 418 F.2d 528, 163 USPQ 644 (CCPA 1969).

A timely filed terminal disclaimer in compliance with 37 CFR 1.321(c) may be used to overcome an actual or provisional rejection based on a nonstatutory double patenting ground provided the conflicting application or patent is shown to be commonly owned with this application. See 37 CFR 1.130(b).

Effective January 1, 1994, a registered attorney or agent of record may sign a terminal disclaimer. A terminal disclaimer signed by the assignee must fully comply with 37 CFR 3.73(b).

Respective claims 1-11, 13-17 and 19-23 are rejected under the judicially created doctrine of obviousness-type double patenting as being unpatentable over claims 14 or 15, 15, 18, 21, 24, 14, 16, 16, 19, 22, 25, 17, 17, 20, 23, 26, 29, 29, 30, 30 and 13 of U.S. Patent No. 6,025,882.

Although the conflicting claims are not identical, they are not patentably distinct from each other because allowing these claims of the instant application would result in an unjustified time-wise extension of the monopoly granted for the invention defined in the respective claims of the US Patent..

The patented claims cover the pending claims because they encompass the same subject matter of the respective pending claims since they are more specific than the corresponding pending claims. For example, a "television" signal covers an "information bearing" signal, and the blanking intervals cover the signal portion unused for program content. Likewise, fields or frames cover the signal segments, and high-definition television image covers an enhanced information-bearing signal.

Pending claims 24-28 and 30-36 are also rejected under the same doctrine over claims 14 or 15, 15, 18, 21, 24, 14 and 14 or 15, 15, 18, 21, 24 and 14, respectively, of the US Patent 6,025,882.

Art Unit: 2614

It would have been obvious to one of ordinary skill in the art to store or record the product produced by the respective processes covered by the respective patented claims for the clear purpose of allowing one to enjoy the product at any convenient time as so preferred, and for multiple subsequent presentations (such being the principal purpose of recording).

Likewise distribution of the product resulting from the respective processes would also have been obvious to one of ordinary skill in the art for the clear purpose of making available to and allowing the enjoyment of the product to an extended body of viewers, by distribution through any suitable transmission or transportation, or multiple transfer of the product to reach the members of the viewer base.

4. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

Or (e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

Claims 1-3, 14, 15, 24-26 and 31-33 are rejected under 35 U.S.C. 102(e) as being anticipated by Iue et al.

The system of Iue (noting Figs. 4, 8-11, 13 and 14) involves 2D/3D data that is encoded in the VBI of a video signal (col. 16 lines 18-28) of a first segment of the video signal (e.g. a current field) and applied to a subsequent field to supplement its presentation (and not before its

Art Unit: 2614

presentation), and thereby provide a delayed operation (col. 16 lines 29-34) resulting in a 3D displayed, thereby meeting claims 1 and 2.

As for claim 3, the supplemental data in the VBI is information that can be considered image area map information because it is used to present the second segment data in a shifted or remapped position output from memory.

Regarding claims 14 and 15, the second segment is distinct from the first (at least by virtue of it being a separate field), and subsequent thereto.

As for claims 24-26, the product (i.e. encoded video signal) is recorded (noting Figs. 9 and 10).

As for claims 31-33, the product can also be transmitted for distribution to the viewing public (noting Fig. 11).

5. Claims 1, 4, 16, 19-23, 27 and 34 are rejected under 35 U.S.C. 102(e) as being anticipated by Lappington et al.

The system of Lappington (noting Fig. 1) involves encoding commands related to interactive programming in the VBI of a video broadcast (col. 7 lines 31-36), which commands are transmitted at an initial segment of the broadcast for subsequent involvement with a second segment of the broadcast to be presented and interacted with by a viewer. The commands are therefore supplemental information utilized in association with, but not before the presentation of, the interactive data related to the second segment (e.g. col. 2 lines 40-57; col. 3 lines 4-17; col. 4 lines 5-11; col. 11 lines 5-25), thereby meeting claims 1 and 4.

Art Unit: 2614

As for claims 16, 19 and 20, the second segment is subsequent to the first and (at least) distinct therefrom because it is presented at a separate later time.

As for claims 21 and 22, the supplemental data is associated with the second segment, and the data is extracted from processing after encoding and before utilization with the second segment for display.

Considering claims 27 and 34, the video product (resulting from the composite encoded broadcast signal) can be recorded as shown (element 50) and distributed through conventional broadcasting (channel 36).

6. Claims 1, 5, 17, 23, 28 and 35 are rejected under 35 U.S.C. 102(e) as being anticipated by Long.

The system of Long (Fig. 2 or 4) involves embedding control (i.e. supplemental) data into the video blanking portions of an initial segment of an A/V signal intended to be used with, but not before the presentation of, second subsequent segments of the A/V signal, resulting in display of multimedia data (which is a type of hypermedia data) subsequent to the initial encoding of the control data (e.g. col. 1 lines 33-40 and 50-54; col. 2 lines 36-44; col. 5 lines 10-19), thereby meeting claims 1 and 5.

As for claim 17, the second segment is distinct and subsequent to the first segment.

As for claim 23, the video source of Long includes standard processing capable of presenting A/V program content from a standard portion of the source signal; extracting means for removing the embedded supplemental data from the VBI from the first segment; elements 208, 212 and 214 (Fig. 2, Fig. 4 also showing corresponding elements) that stores supplemental

Art Unit: 2614

information that is to be created for presentation; and display 210 for simultaneously presenting the standard program content and the supplemental (multimedia) data derived from a previous segment distinct from the currently displayed segment (col. 5 lines 12-19).

Regarding claims 28 and 35, the product can be recorded (noting elements 219 and 400), and the recorded medium is typically distributed for presentation at multiple stations.

7. Claims 1, 6, 18, 30 and 36 are rejected under 35 U.S.C. 102(e) as being anticipated by Duffield et al.

The system of Duffield (noting Figs. 1 and 2) involves encoding EDS data in the blanking portion that includes timing data (i.e. supplemental data) in a first segment of a video signal (col. 1 lines 13-23). In response to control codes prompted by the user, the timing data of a subsequent segment is compared with the timing data encoded in the first component and if a predetermined value is detected, the second segment is operated on, and the first data is therefore utilized in association with, but not before presentation of, the second segment (e.g. col. 2 lines 5-17 and lines 25-42), thereby meeting claim 1.

As for claim 6, the timing data is neither type of data listed in the group.

As for claim 18, the second segment is subsequent to and therefore distinct (at least temporally) from the first.

Considering claims 30 and 36, the resultant signal product can be broadcast (i.e. distributed, noting RF input 100), and recorded (e.g. col. 1 line 45).

Art Unit: 2614

8. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure. Applicant should note that the remaining patents to Harper, Cobbley, Cragun and Miller are all pertinent to the claimed invention in that they all teach, in some manner, embedding supplemental data into the VBI of a first segment of a video signal, data to be used with subsequent segments of the video signal.

9. The patentability of claims 7-12 based on prior art has not been determined due to the ambiguity of the subject matter recited therein (so addressed above).

10. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Victor R. Kostak whose telephone number is 703 305-4374. The examiner can normally be reached on Monday - Friday from 6:30am-3:00pm.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, John W. Miller can be reached on 703 305-4795. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

Art Unit: 2614

Any response to this action should be mailed to:

Commissioner of Patents and Trademarks
Washington, D.C. 20231

Or faxed to:

(703) 872-9306 (for Technology Center 2600 only)

Hand-delivered responses should be brought to Crystal Park II, 2121 Crystal Drive, Arlington, VA., Sixth Floor (Receptionist).

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the Technology Center 2600 Customer Service Office whose telephone number is (703) 308-HELP.



Victor R. Kostak
Primary Examiner
Art Unit 2614

VRK